

Remarks

Claims 9, 12 and 14 have been amended as requested in the Office Action. Applicant confirms the election of claims 1 to 15 and cancel Claim 16. Claim 15 is also cancelled.

The Examiner rejects claims 1-8 under USC §103(a) as being obvious over AAPA in view of Borella (US 6,697,354) and further in view of Hung (US 6,760,429). Applicant respectfully disagrees for the following reasons.

The present invention is concerned with establishing a communications path in a multi-homed network. In particular, it is concerned with enabling the establishment of a more direct communications path where signaling may otherwise flow through a first and a second address translator interconnecting two different network address domains.

In contrast, Borella is concerned with the operating efficiencies of network address translators (NATs) themselves in a mobile communication network (see abstract and column 2 line 33 to column 3 line 58). Borella is not concerned with the communications paths employed to connect calls, only with the functioning and efficiencies of the NATs themselves.

In even starker contrast, Hung is concerned with a Web based agent backed system that provides service and sales support for a company with a call center employing a number of call agents (see abstract). This has nothing whatsoever to do with the field of the present invention.

Nevertheless, the Examiner argues that one skilled in the art would be motivated to combine the AAPA with the teachings of Borella and Hung to arrive at the present invention.

In *ex parte* examination of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent and Trademark Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success

must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Prior art fails to teach or suggest all the claim limitations

The Examiner argues that Borella teaches the claimed feature of:

“retaining the address of the first entity within the first address domain in the call set-up message as well as adding information about the identity of the first address domain to the call set-up message”.

The Examiner cites column 17 lines 23-41 of Borella. However, this passage fails to teach the feature. The passage teaches how a network interface card, for use in the distributed NAT system of Borella, functions on receipt of a data packet - ie an Internet Protocol (IP) packet. If the destination address of the data packet is for an external network, the network interface card encapsulates the data packet within a further data packet by adding an additional IP header. The Examiner should note three key distinctions between this teaching and the claimed feature:

- 1) the teaching shows how a data packet is handled at the network interface card of the Borella system, not how a call set-up message is handled. One skilled in the art would know that although a call set-up message may be contained in the payloads of one or more IP data packets, a call set-up message is not the same as an IP data packet. There is no teaching in the passage of Borella of what such a data packet may contain (ie as its payload), nor any teaching of performing any action in respect of the contents of such a data packet. Since there is no teaching of performing any action on the contents – ie payload - of the data packet, one skilled in the art would not learn from Borella to retain the address of the first entity within the first

address domain in the call set-up message as well as adding information about the identity of the first address domain to the call set-up message.

- 2) By teaching that an outer IP header is attached to the data packet (line 31) Borella is teaching the well-known function of encapsulation. Encapsulation is where a data packet is encapsulated within another data packet. In Borella, encapsulation is used so that the network interface card may forward the received data packet to router 26 in the distributed NAT system where it may be decapsulated (ie the outer IP header removed) to leave the original data packet undisturbed. Thus, one skilled in the art would not learn from Borella to retain the address of the first entity within the first address domain in the call set-up message as well as adding information about the identity of the first address domain to the call set-up message.
- 3) It seems to the Applicant that there is no disclosure in the passage cited, or in Borella as a whole, of adding information about the identity of the first address domain to the call set-up message. The destination address of the outer IP header is set to the IP address of router 26 (lines 33-34). This is not information about the identity of the first address domain.

Clearly, therefore, Borella fails to teach the claimed feature as argued by the Examiner.

The Examiner further argues that Hung teaches the claimed feature of:

“forwarding the call set-up message to the second entity via a second one of the address domains and a second one of the address translators such that the information in the call set-up message can be used to establish a communications path from the second entity to the first entity which excludes one or more of said address domains” [alleged teaching underlined].

Applicant has tried his best to understand the nature of the Examiner's argument but is still uncertain how the passages cited (or indeed the whole of Hung) is at all relevant. The Examiner cites column 4 lines 16-17 and 26-38 of Hung. These passages teach how a call center computer system collects information from a customer computer enabling a call center agent to call him or her back. The information includes whether the call is to be an IP telephony call or a PSTN call. The call center agent may then place the call to the customer either via a packet-switched network (ie a VoIP network) or via a traditional Public Switched Telephone Network (PSTN). Applicant believes this provides no teaching of relevance to the claimed feature.

In summary, then, Applicant firmly believes that even if one skilled in the art were to combine the teachings of AAPA, Borella, and Hung, the propriety of which is denied, he or she would fail to arrive at the invention as claimed.

No motivation or suggestion to combine

Moreover, Applicant strongly denies that one skilled in the art would be motivated to combine the teachings of AAPA, Borella, and Hung.

Regarding Borella, the Examiner argues that "it would have been obvious for one skilled in the art to combine the teachings of AAPA and Borella because Borella's teaching of adding header with source address and destination address enables AAPA to further insert data into the message and allows the receivers to identify the sender by using the addresses incorporated in the message." In view of the above discussion of Borella, Applicant believes it is now clear that Borella does not enable AAPA to do anything with the call setup message as suggested by the Examiner. The relevance of allowing "the receivers to identify the sender by using the addresses incorporated in the message" is unclear. In any event, it is not seen how any of this constitutes any motivation to combine. The Examiner is reminded that

Borella is concerned with improving the efficiency of NAT functions by creating a distributed NAT system, not with enabling improved communications paths to be employed to connect calls. Accordingly, one skilled in the art would not be motivated to combine the teachings of AAPA and Borella.

Regarding Hung, the Examiner argues that "it would have been obvious for one skilled in the art to combine the teachings of AAPA, Borella and Hung because Hung's teaching of establishing communications in response to receiving a request enables AAPA and Borella's system to establish communication by using the information obtained from the request and determining a proper communication path." Applicant fails to understand the significance of this. The Examiner is reminded that Hung is concerned with a Web based agent backed system that provides service and sales support for a company with a call center employing a number of call agents. Applicant believes that one skilled in the art would find no motivation to combine the teachings of Hung with either those of AAPA or those of Borella which lie in completely unrelated fields of endeavor.

No expectation of success

From the above, Applicant believes it is abundantly obvious that one skilled in the art would entertain no expectation of success at all in combining the respective teachings of these three disparate references. It is totally unclear how one skilled in the art would even embark upon such a combination.

Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness that claims 1-8 are unpatentable over the prior art references cited.

The Examiner rejects claims 9-14 under USC §103(a) as being obvious over AAPA in view of Borella (US 6,697,354) and further in view of Official Notice. Applicant

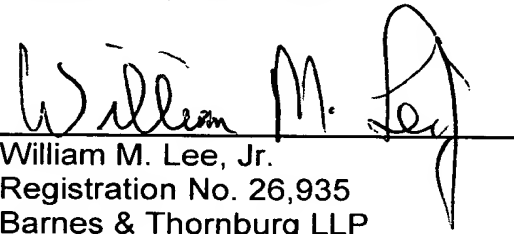
respectfully disagrees for the reasons already discussed above in relation to claims 1-8. Regarding the Official Notice, Applicant is uncertain of its significance, given the discussion above, and therefore as a precautionary measure makes no admissions in respect of it.

In conclusion, Applicant firmly believes that the invention as claimed is novel and non-obvious in view of the prior art references raised by the Examiner and request favorable consideration.

An appropriate Petition for Extension of Time is also submitted herewith.

October 31, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William M. Lee, Jr.", is written over a horizontal line. The signature is stylized with a large, looped "L" at the end.

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